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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,068	01/19/2001	Jeff Scott Eder		6669

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JEFF EDER
19108 30TH DRIVE SE
MILL CREEK, WA 98012

EXAMINER

GRAHAM, CLEMENT B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,068

Applicant(s)

EDER, JEFF SCOTT

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/31/04, 5/10/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Handwritten mark or signature.

DETAILED ACTION

1. **Claims 1-35 has been cancelled and claims 36-70 has been added.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 36-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall . U.S Patent 6, 073, 115 in view of Tull, Jr, U. S. Patent 6, 092, 056.

As per claims 36-45, Marshall discloses an enterprise method, comprising: integrating transaction data related to a commercial enterprise in accordance with a common schema, and developing a model of enterprise market value by element and category of value by completing a series of multivariate analyses that utilize at least a portion of said data where the categories of value are selected from the group consisting of current operation, real option, market sentiment and combinations thereof.(see column 3 lines 43-67 and column 4 lines 1-67 and column 5 lines 1-31).

Marshall fail to explicitly teach where the elements of value are selected from the group consisting of alliances, brands, channels, customers, customer relationships, employees, intellectual property, partnerships, processes, vendors and vendor relationships and combinations thereof.

However Tull, Jr discloses providing data processing means for determining a price for a basket of shares which is packaged as a debt instrument so as to reflect the current aggregate value of the shares and accrued income and expenses associated with all shares in the basket. (see column 3 lines 33-37) and provide a financial management system to develop and administer a financial debt instrument traded as a listed security to investors desiring to track the performance of a domestic or foreign

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capital market.(see column 3 lines 20-25 and column 6 lines 6-15 and column 7 lines 1-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Marshall to include where the elements of value are selected from the group consisting of alliances, brands, channels, customers, customer relationships, employees, intellectual property, partnerships, processes, vendors and vendor relationships and combinations thereof taught by Tull, Jr in order to manage financial debt instruments designed for investors whose objective is to track the performance of certain security markets within a limited period of time. More particularly, the invention relates to an integrated financial management system for implementing investor participation in domestic and foreign capital markets through positions in indexed vehicles which are packaged as debt instruments.

As per claims 46-54, Marshall discloses a program storage device readable by machine, tangibly embodying a program of instructions executable by a machine to perform method steps for performing an element method, the method steps comprising: integrating enterprise transaction data in accordance with a common model or schema, analyzing at least a portion of the data using a neural network model to identify one or more indirect indicators of value for each element of value by category of value where the categories of value are selected from the group consisting of current operation, real option, market sentiment' and combinations thereof.(see column 3 lines 43-67 and column 4 lines 1-67 and column 5 lines 1-31 and column 20-23 lines 1-60).

Marshall fail to explicitly teach determining a net relative contribution for each element to each category of value by modeling enterprise financial performance with said indirect indicators by category and element of value, calculating a value for each element of value using said contributions, and reporting the element values using an electronic display or a paper document.

However Tull, Jr discloses providing data processing means for determining a price for a basket of shares which is packaged as a debt instrument so as to reflect the current aggregate value of the shares and accrued income and expenses associated with all shares in the basket. (see column 3 lines 33-37) and provide a financial management

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system to develop and administer a financial debt instrument traded as a listed security to investors desiring to track the performance of a domestic or foreign capital market.(see column 3 lines 20-25 and column 6 lines 6-15 and column 7 lines 1-65 and column 16 lines 54-67 and column 17-18 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Marshall to include determining a net relative contribution for each element to each category of value by modeling enterprise financial performance with said indirect indicators by category and element of value, calculating a value for each element of value using said contributions, and reporting the element values using an electronic display or a paper document taught by Tull, Jr in order to manage financial debt instruments designed for investors whose objective is to track the performance of certain security markets within a limited period of time. More particularly, the invention relates to an integrated financial management system for implementing investor participation in domestic and foreign capital markets through positions in indexed vehicles which are packaged as debt instruments.

As per claims 55-63, Marshall discloses a future market value method, comprising: integrating enterprise related data in accordance with a common model or schema, developing a causal model of net element contribution to enterprise market value by category of value using at least a portion of said data, and identifying one or more element related changes that will optimize a future market value portion of enterprise market value by analyzing said model. (see column 3 lines 43-67 and column 4 lines 1-67 and column 5 lines 1-31 and column 20-23 lines 1-60).

As per claims 64-70, Marshall discloses a composite application method, comprising: using two or more independent components of application software to produce one or more useful results by processing enterprise related data where said enterprise related data has been integrated from two or more enterprise management systems in accordance with a common model or schema defined by an xml metadata standard. (see column 3 lines 43-67 and column 4 lines 1-67 and column 5 lines 1-31 and column 20-23 lines 1-60).

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65. (new) The method of claim 64 where the independent components of application software can be flexibly combined as required to support the development of one or more useful results.

Conclusion

Response to arguments

4 Response to arguments filed 12/31/2004 has been considered but they are moot in view of new grounds of rejections.

5. With respect to Applicant's argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ* 685, 686 (Fed. Cir. 1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 10). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. &, 4/293 Therefore the combination of reference is proper and the rejection is maintained.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

June 24, 2005


FRANKY BONVIL
PRIMARY EXAMINER
AY 3628